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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,172	11/26/2003	James A. McEwan	27049-24	5747

7590

01/24/2005

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EXAMINER

TRIEU, THAI BA

ART UNIT	PAPER NUMBER
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3748

DATE MAILED: 01/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/723,172		MCEWAN, JAMES A.	
	Examiner		Art Unit	
	Thai-Ba Trieu		3748	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/361,612.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

The Preliminary Amendment filed on November 26, 2003 is acknowledged.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character **"20"** has been used to designate both **"outlet pipe"** (See Figures 1 and 3; and page 5, line 23); and **"valve stem"** (See Figure 2; Page 6, line 25; Page 7, line 24; and Page 8, line 9). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Claims **2-9 and 11-12** are objected because of the following minor informalities:

- In claims 2-9, line 1, **"Apparatus as claimed in "** should be replaced by
- **The apparatus as claimed in --.**

- In claims 11-12, line 1, "**Method of assembling**" should be replaced by
-- The method of assembling--.

Appropriate correction is required.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim **1** is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim **1** of U.S. Patent No. 6,658,846 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim **1** of the patent anticipates application claim **1**. Accordingly, application claim **1** is not patentably distinct from patent claim **1**.

Patent claim **1** requires following elements:

- an actuator rod for a turbocharger pressure control assembly,
- the actuator comprising:
 1. a first elongate portion defining a first rod end,

2. a second portion defining a second rod end,
3. said first and second portions being pivotally joined to one another to allow a degree relative pivotal motion between said two portions in at least one plane perpendicular to the axis of said elongate first portion, and
4. said second portion of the actuator rod being welded to said lever arm.

whereas, the instant application claim 1 required following elements:

- an actuator rod for a turbocharger pressure control assembly,
- the actuator comprising:
 1. a first elongate portion defining a first rod end,
 2. a second portion defining a second rod end, and
 3. said first and second portions being pivotally joined to one another to allow a degree relative pivotal motion between said two portions in at least one plane perpendicular to the axis of said elongate first portion.

Thus it is apparent that the more specific patent claim 1 encompasses application claim 1. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal

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disclaimer. Note that since Application claim 1 anticipated by Patent claim 1 and since anticipation is the epitome of obviousness, then Application claim 1 is obvious over Patent claim 1.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 10-12 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 9-11 of prior U.S. Patent No. 6,658,846 B1. This is a double patenting rejection.

Patent Number	Instant Application
6,658,646 B1	10/723,172
Claim 9	Claim 10
A method of assembling a pressure control assembly of a turbocharger...., the method comprising:	A method of assembling a pressure control assembly of a turbocharger...., the method comprising:...

- assembling the valve... housing;	- assembling the valve... housing;
- assembling the pneumatic actuator ... sub-assembly;	- assembling the pneumatic actuator ... sub-assembly;
- mounting the pneumatic actuator... turbocharger; and	- mounting the pneumatic actuator... turbocharger; and
- securing the second... arm.	- securing the second... arm.
Claim 10	Claim 11
the actuator being secured to the lever arm by welding or otherwise bonding.	the actuator being secured to the lever arm by welding or otherwise bonding.
Claim 11	Claim 12
prior to securing the actuator rod to the lever arm ...said valve will in use begin to open.	prior to securing the actuator rod to the lever arm ...said valve will in use begin to open.

Since the application claims **10-12** are anticipated by Patent claims **9-11**, and since the anticipation is the epitome of obviousness, then, application claims **10-12** are obvious over Patent claims **9-11**.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Metzfeld (Patent Number 5,033,592).

Metzfeld discloses an actuator rod for a turbocharger pressure control assembly, the actuator rod comprising a first elongate portion (30) defining a first rod end, and a second portion defining a second rod end (12), said first and second portions being pivotally joined to one another to allow a degree of relative pivotal motion between said two portions in at least one plane perpendicular; and in at least two orthogonal planes perpendicular to the axis of said first elongate portion (26) (See Figure 1, Column 4, lines 65-68).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Metzfeld (Patent Number 5,033,592), in view of Hauer (Patent Number 4,994,660).

Metzelfeld discloses the invention as recited above; however, Metzelfeld fails to disclose the pivot joint being spherical; a socket defined by the other of said first and second portions to receive said spherical formation; a pneumatic actuator connected to said first rod end.

Hauer teaches that it is conventional in the linking mechanism art, to utilize the pivot joint being spherical (68); a socket defined by the other of said first and second portions to receive said spherical formation; a pneumatic actuator (70) connected to said first rod end (73) (See Figures 2 and 6, and Column 4, lines 36-40.

It would have been obvious to one having ordinary skill in the art at that time the invention was made, to have utilized the pivot joint being spherical; a socket defined by the other of said first and second portions to receive said spherical formation; a pneumatic actuator connected to said first rod end, as taught by Hauer, to improve the performance of the joint in the Metzelfeld device.

Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Metzelfeld (Patent Number 5,033,592), in view of Hauer (Patent Number 4,994,660), and further in view of Braddick (Patent Number 4,526,019).

Regarding claim 6-8, the Modified Metzelfeld device discloses the invention as recited above; however, fails to disclose the pneumatic actuator comprising a spring loaded diaphragm housed within a pressure chamber, the diaphragm being attached to the first rod end; a valve assembly, end of said actuating rod being connected to said actuator and the other end being connected to the valve assembly, whereby the pneumatic actuator controls of the valve assembly via the actuator rod; the valve

assembly further comprising a lever arm extending from and connected to a valve , said second portion of the actuator rod being secured to said lever arm extending from the valve assembly by way of which the valve is operated.

Braddick teaches that it is conventional in the turbocharger control actuator art, to utilize the pneumatic actuator (10) comprising a spring (48) loaded diaphragm housed within a pressure chamber (50), the diaphragm being attached to the first rod end (58); a valve assembly (32), end of said actuating rod being connected to said actuator and the other end being connected to the valve assembly, whereby the pneumatic actuator controls of the valve assembly via the actuator rod (See Abstract, Figure 1, Columns 1-2, lines 1-67, and Column 3, lines 1-20); the valve assembly further comprising a lever arm (36) extending from and connected to a valve (32), said second portion of the actuator rod being secured to said lever arm extending from the valve assembly by way of which the valve is operated (See Column 1, lines 1-24).

It would has been obvious to one having ordinary skill in the art at that time the invention was made, to have utilized the pneumatic actuator, as taught by Braddick, to improve the control of the modified Metzfeld device.

Regarding claim 9, the Metzfeld device discloses the invention as recited above; however, fails to disclose said second portion of the actuator rod being welded to said lever arm.

The recitation of "said second portion of the actuator rod being welded to said lever arm" is considered as a product by process claim is rejected over a prior art

product that appears to be identical, although produced by a different process, the burden is upon the applicants to overcome forward with evidence establishing a obvious difference between the two. See *In re Marosi*, 218 USPQ 289 (Fed. Cir. 1983).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Gauthier et al. (US Patent Number 5,186,004) disclose an assembly consisting of a brake booster and of a master cylinder.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thai-Ba Trieu whose telephone number is (571) 272-4867. The examiner can normally be reached on Monday - Thursday (6:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas E. Denion can be reached on (571) 272-4859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TTB
January 17, 2005



Thai-Ba Trieu
Primary Examiner
Art Unit 3748